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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/845,267	05/01/2001	Timothy Merrick Long	169.2039	3091

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FITZPATRICK CELLA HARPER & SCINTO  
30 ROCKEFELLER PLAZA  
NEW YORK, NY 10112

EXAMINER
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CHAMPAGNE, DONALD

ART UNIT	PAPER NUMBER
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3688

MAIL DATE	DELIVERY MODE
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06/02/2008

PAPER

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

<b>Office Action Summary</b>	<b>Application No.</b> 09/845,267	<b>Applicant(s)</b> LONG, TIMOTHY MERRICK	
	<b>Examiner</b> Donald L. Champagne	<b>Art Unit</b> 3688	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 27 February 2008.
- 2a) ☒ This action is **FINAL**.                      2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 25,29-31,37 and 38 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 25,29-31,37 and 38 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 01 May 2001 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All    b) ☐ Some \*    c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- |  |   |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)  | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)                                   | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)             |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)<br>Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____  |

## DETAILED ACTION

### ***Claim Rejections - 35 USC § 101***

1. 35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

2. Claims 29-31, 37 and 38 are rejected under 35 U.S.C. 101 because the claimed invention is not directed to non-statutory subject matter. At claim 29 line 1, a “business system” is not one of the four enumerated statutory categories (MPEP § 2106.IV.B). Claim 29 has the characteristics of two categories: (1) the characteristics of a “system”, which the Office interprets as the enumerated statutory category “machine” (i.e., the “information appliance” beginning on line 3 of claim 29), and (2) the characteristics of a process/method, the “information display business system” beginning 10 lines from the end of claim 29. Each claim must be limited to a statutory category, not to two or more categories.

### ***Claim Rejections - 35 USC § 112***

3. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

4. Claims 25, 29-31, 37 and 38 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention. “Non-advertising/advertising information which is created by any of a plurality of non-advertising applications being run on said information appliance” (e.g., at claim 25 lines 3-4) and “advertising information which is created by software being run on said information appliance” (e.g., at claim 25 lines 5-6) are new matter. The spec. (para. [0107] of the published application US 20020007310A1) does disclose that advertising **space 202** is created, but does not anywhere disclose creation of the ad or other information by applications/software run on said information appliance.

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5. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

6. Claims 25, 29-31, 37 and 38 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. The claimed distinction between “advertising” and “non-advertising” information is indefinite. The Office recognizes *functional* differences, e.g., when “advertising” is targeted, but in general, “advertising” is anything that promotes, so any information can readily be “advertising”. The spec. (para. [0106] of the published application) does disclose an *advertising display area 202*. The examiner will accept that any information displayed in *advertising display area 202* is advertising.

***Claim Rejections - 35 USC § 102***

7. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

8. Claim 25, 29-31, 37 and 38 is rejected under 35 U.S.C. 102(b) as being anticipated by Marsh et al. (US005933811A). Marsh et al. teaches an information appliance (*client system 101*, col. 6 lines 4-6), comprising:

a display (*display terminal monitor 208*, col. 6 lines 4-6) having a working display (**1001** in Fig. 4) area and an advertising display area (**601** in Fig. 4) wherein said working display area is configured to display non-advertising information (the *email read and write screens*, col. 7 lines 30-35) which is created by any of a plurality of non-advertising applications (*e-mail software*, col. 7 lines 21-25) being run on said information appliance, and wherein said advertising display area is configured to display advertising information which is controlled by *advertisement display scheduler 700* (col. 8 lines 34-42) software being run on said information appliance, which reads on “created by” software being run on said information appliance, independently of the non-advertising information (col. 3 lines 51-56), even when

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any of the plurality of non-advertising applications creates non-advertising information on the working display area;

input means (*communications interface 102*, col. 5 lines 50-54) configured to accept an upgrade (*new banner advertisements*, col. 13 lines 58-62) for the software;

a memory (*permanent storage device 206*, col. 5 lines 59-65) configured to store at least the plurality of non-advertising applications and the software;

a processor (*central processing unit 209*, col. 5 lines 56-59) coupled to each of said input means, said display and said memory, and constructed to execute said upgrade to update the advertising information, to display said updated advertising information on said advertising display area independently of the non-advertising information, even when any of the plurality of non-advertising applications creates non-advertising information and to cause said display to continuously display the advertising information on said advertising display area as long as said information appliance is operational.

9. Claim scope is not limited by claim language does not limit a claim to a particular structure (MPEP § 2111.04). Accordingly, no patentable weight was given to the last 10 lines of claim 29, which begin with “wherein the information display business system comprises”.
10. Claims 30, 31, 37 and 38 also add no structure to claim 29 and were therefore not given patentable weight.

### ***Response to Arguments***

11. Applicant's arguments filed with an amendment on 27 February 2008 have been fully considered but they moot in view of the new basis of rejection.

### ***Conclusion***

12. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).
13. A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will

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expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

14. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Donald L Champagne whose telephone number is 571-272-6717. The examiner can normally be reached from 9:30 AM to 8 PM ET, Monday to Thursday. The examiner can also be contacted by e-mail at [donald.champagne@uspto.gov](mailto:donald.champagne@uspto.gov), and *informal* fax communications (i.e., communications not to be made of record) may be sent directly to the examiner at 571-273-6717. The fax phone number for all *formal* matters is 571-273-8300.
15. The examiner's supervisor, James W. Myhre, can be reached on 571-272-6722.
16. Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).
17. **AFTER FINAL PRACTICE** – Consistent with MPEP § 706.07(f) and 713.09, prosecution generally ends with the final rejection. Examiner will grant an interview after final only when applicant presents compelling evidence that “disposal or clarification for appeal may be accomplished with only nominal further consideration” (MPEP § 713.09). The burden is on applicant to demonstrate this requirement, preferably in no more than 25 words. Amendments are entered after final only when the amendments will clearly simplify issues, or put the case into condition for allowance, clearly and without additional search or more than nominal consideration.
18. Applicant may have after final arguments considered and amendments entered by filing an RCE.

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19. **ABANDONMENT** – If examiner cannot by telephone verify applicant's intent to continue prosecution, the application is subject to abandonment six months after mailing of the last Office action. The agent, attorney or applicant point of contact is responsible for assuring that the Office has their telephone number. Agents and attorneys may verify their registration information including telephone number at the Office's web site, [www.uspto.gov](http://www.uspto.gov). At the top of the home page, click on Site Index. Then click on Agent & Attorney Roster in the alphabetic list, and search for your registration by your name or number.

28 May 2008

/Donald L. Champagne/  
Primary Examiner, Art Unit 3688